

BS



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,030	11/29/2000	Ashley Stuart Davis		8960

7590 04/08/2005
Cytoskeleton Inc.
c/o Ashley Davis
1830 S. Acoma St.
Denver, CO 80223

EXAMINER

LUKTON, DAVID

ART UNIT PAPER NUMBER

1653

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 09/725,030	Applicant(s) DAVIS ET AL.	
	Examiner David Lukton	Art Unit 1653	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☒ They raise the issue of new matter (see NOTE below);
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: none.
 Claim(s) objected to: none.
 Claim(s) rejected: 8-21 and 23.
 Claim(s) withdrawn from consideration: 3,4,22 and 24.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see accompanying sheets.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
 13. ☐ Other: _____

Advisory Action

The response filed 7/7/04 directs the amendment of claims 8-21 and 23, and the addition of claim 25. However, this amendment will not be entered. Claim 25, for example, recites various intended use limitations which may not be adequately described in the specification. For example, it is not clear where in the application it is stated that the bromo- compound fails to exhibit the recited "unique combination of effects". In addition, new limitations have been added to each of claims 8-21 which raise new issues under 35 USC §112, first and second paragraphs. Accordingly, the amendment will not be entered.



The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This ground of rejection has not been traversed, and is maintained without further

comment.



Claims 8-21, 23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,294,695. Although the conflicting claims are not identical, they are not patentably distinct from each other.

In the response filed 7/7/04, it is argued essentially that the "intended use" limitation of the instant claims is effective to overcome this ground of rejection. However, a compound and its properties are inseparable, and the patented genus (USP '695) encompasses the compound of the instant claims. If it is true that the compound of the instant claims has the recited properties, then it was true at the time of filing of the '695 patent. Accordingly, the rejection is maintained.



Claims 9-21, 23 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This ground of rejection is maintained, since the after-final amendment has not been entered.



Claim 8 is rejected under 35 U.S.C. §102(a) as being anticipated by Jiang (*Cancer*

Research 58, 2126, 1998).

Applicants have traversed this ground of rejection by arguing that claim 25 should not be rejected. However, claim 25 has not been rejected; claim 8 has been rejected.

Accordingly, the rejection is maintained.



Claim 8 is rejected under 35 U.S.C. §103 as being unpatentable over Jiang (*Anti-cancer Drug Design* 13, 735, 1998) in view of Alberts (*The Molecular Biology of the Cell*, 2nd Ed., 1989, pages 727 - 786).

This ground of rejection has not been traversed, and is maintained without further comment.



Claim 8 is rejected under 35 U.S.C. §103 as being unpatentable over Abraham I. (*Proc Natl. Acad. Sci.* 83, 6839-43, 1986) in view of Alberts (*The Molecular Biology of the Cell*, 2nd Ed., 1989, pages 727 - 786).

This ground of rejection has not been traversed, and is maintained without further comment.



Claim 8 is rejected under 35 U.S.C. §103 as being unpatentable over Sorger P.K. (*Curr Opin Cell Biol.* 9, 807-814, 1997) in view of Alberts (*The Molecular Biology of the Cell*, 2nd Ed., 1989, pages 727 - 786).

This ground of rejection has not been traversed, and is maintained without further comment.



Claim 8 is rejected under 35 U.S.C. §103 as being unpatentable over Jordan (*Current Opinion in Cell Biology* 10 (1) 123-30, 1998) in view of Alberts (*The Molecular Biology of the Cell*, 2nd Ed., 1989, pages 727 - 786).


This ground of rejection has not been traversed, and is maintained without further comment.

✦

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber, can be reached at 571-272-0925. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.


DAVID LUKTON
PATENT EXAMINER
GROUP 1800